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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|

09/160,916 09/25/98 WOOLFORD

PM21/1203
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| M | 3616, 20USC3 |
| EXAMINER | |

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| ATTORNEY, D | PAPER NUMBER |
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DATE MAILED:

12/03/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action SummaryApplication No.
09/160,916Applicant(s)
Woolford, M. et alExaminer
Dennis L. TaylorGroup Art Unit
3672☐ Responsive to communication(s) filed on _____.☐ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims☒ Claim(s) 1-29 is/are pending in the application.Of the above, claim(s) 23-29 is/are withdrawn from consideration.☐ Claim(s) _____ is/are allowed.☒ Claim(s) 1-22 is/are rejected.☐ Claim(s) _____ is/are objected to.☒ Claims 1-29 are subject to restriction or election requirement.**Application Papers**☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on _____ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119**☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.☐ received in Application No. (Series Code/Serial Number) _____.☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)**☐ Notice of References Cited, PTO-892☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____☐ Interview Summary, PTO-413☒ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-22, drawn to a block/retaining wall, classified in class 405, subclass 284.
- II. Claims 23-29, drawn to a mold/method of using, classified in class 249, subclass 63.

The inventions are distinct, each from the other because:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the block could be made by injection molding.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. John J. Gresens on December 1, 1998 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-22. Affirmation of this election must be made by applicant in replying to this Office action.

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Claims 23-29 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

DOUBLE PATENTING REJECTION(S)

Claims 1-22 are considered to be rejectable over the claimed disclosure of patent No. U.S. 5,827,015, of which this is a continuation, on the basis of judicially-created non-statutory double patenting. See *In Re Schneller*, 397, F.2d. 350; 158 USPQ 210 (CCPA 1968).

A perusal of the instant claims clearly indicates that the subject matter thereof is fully disclosed by the claims of said patent and/or that portion of the patent disclosure which provides support for such claims. See *In Re Vogel*, 422 F.2d. 438; 164 USPQ 619 (CCPA 1970).

Therefore, it is axiomatic that the instant claims are nothing more than an obvious variation of the inventions(s) disclosed and claimed in said patent and cannot properly issue in the absence of a terminal disclaimer. Furthermore, it is also clear that the inventions could have included the instant claims in said patent and that if the instant application were to issue without a terminal disclaimer, protection of the previously patented inventions(s) would be improperly extended until the expiration of the instant claims since the utilization of such inventions(s) would infringe the instant claims.

Unless Applicant(s) is/are of the opinion that the double patent rejection is in error and believes that it can be successfully challenged, in order to expedite prosecution of this

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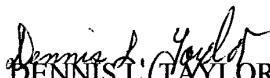
application, Applicant is requested to submit the terminal disclaimer in response to this rejection.

The prior art cited in Applicant(s) prior application has been considered.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Taylor whose **telephone number is (703) 308-1013**. The examiner can normally be reached on Monday-Thursday from 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tamara Graysay, can be reached on (703) 308-2144. The **fax phone number for this Group is (703) 305-3597 or 305-3598**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2168.


DENNIS L. TAYLOR
PRIMARY EXAMINER
ART UNIT 3625

December 1, 1998
(11) 09160916.1st